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In re Application of :
Klaus Krämer et al :
Serial No.: 10/015,559 : PETITION DECISION
Filed: January 23, 2002 :
Attorney Docket No.: 52049 :

This is in response to the petition under 37 CFR 1.181, filed July 13, 2004, requesting withdrawal of Finality of the last Office action. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that the examiner mailed a first Office action to applicants on July 2, 2003, setting a three month shortened statutory period for reply in which claims 1-8 were rejected under 35 U.S.C. 112, second paragraph, as indefinite for the phrase "use of". Claims 1-8 were also rejected under 35 U.S.C. 101 as non-statutory. Claims 9-10 were rejected under 35 U.S.C. 103(a) as unpatentable over Jiang et al.

Applicants replied on November 3, 2003, by canceling claims 1-2 and 10 and amending claims 3-9 and adding claim 11. Claims 3-8 were drafted as "method of use" claims. Applicants argued the amendments overcame each of the rejections of record. A supplemental IDS was filed January 22, 2004.

The examiner mailed a Final Office action to applicants on February 12, 2004, setting a three month shortened statutory period for reply. The examiner maintained the rejection of claims 3-8 under 35 U.S.C. 112, second paragraph, as indefinite for different reasons than in the previous Office action, but related to the amendments to the claims. Claims 3-8 were also rejected under 35 U.S.C. 112, first paragraph, and the specification as failing how to make and use the invention. Claims 3-9 and 11 were then rejected under 35 U.S.C. 103(a) as unpatentable over Jiang et al in view of Burton et al. The examiner made the action Final on the basis that applicants' amendment necessitated the new rejections.

Applicants filed this petition concurrently with a Notice of Appeal and an amendment after Final rejection on July 13, 2004. The amendment has not been acted on by the examiner.

DISCUSSION

Applicants petition the Finality of the last Office action on the basis that the new rejection of claim 9 in the Final Office action of February 12, 2004, was not necessitated by applicants actions or amendments. A review of the Office actions shows that claims 9-10 were rejected over Jiang et al alone in the first Office action. In response thereto applicants canceled claim 10 and incorporated its limitations into claim 9. Thus claim 9 is essentially claim 10 presented in independent form. In the second Office action claim 9 was rejected over a combination of Jiang et al and Burton et al. The making of an Office action Final when claims are amended is permitted when the claims are significantly amended and require utilization of additional references. Here, however, amended claim 9 is essentially the same as previously dependent and now canceled claim 10 rejected in the previous Office action over a single reference. To now reject this claim over a combination of references is a new rejection not necessitated by applicants actions or amendments. Thus making the Office action Final was improper.

The petition is **GRANTED**. The Office action mailed February 12, 2004 is designated a non-Final Office action

As applicants have replied to the February 12, 2004 Office action, the response will be entered and the application will be forwarded to the examiner for further consideration. The Notice of Appeal filed concurrently with the amendment will be held in abeyance. Applicants may request refund of the Appeal Fee if an Appeal becomes unnecessary or, should a proper Final Office action issue, reinstate the Appeal by filing a new Notice of Appeal without any additional Appeal Fee.

There is no fee for this petition and the Petition Fee paid of \$130.00 will be credited to applicants' Deposit Account No. 11-0345, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Bruce M. Kisliuk
Director, Technology Center 1600